

## **REMARKS**

This paper is filed in response to the Office Action dated March 13, 2003. As this paper is filed on August 13, 2003 with a two-month petition for extension of time, the paper is timely filed.

### **I. Status of Amendments**

Claims 1-23 were pending prior to this amendment. By this amendment, applicants amend claims 1, 2, and 11, and cancel claims 10 and 20-23. Thus, claims 1-9 and 11-19 are now pending.

Because applicants previously paid fees for 4 independent and 23 total claims, applicants' amendments do not require a further fee to be paid.

### **II. Response to Office Action**

#### **A      General Comments**

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.<sup>1</sup> For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the

---

<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

term "invention" may be used to refer to subject matter which is nonobvious; and the term "invention" may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term "invention" in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence "As used herein, the term '\_\_\_\_\_ ' is hereby defined to mean..." or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word "means" and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the "broadest reasonable interpretation" of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) ("[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement."). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) ("These cases support our holding that, under proper circumstances, drawings alone may provide a 'written description' of an invention as required by §112").

**B. The March 13 Office Action**

In the March 13 Office Action, the examiner objected to the claim of benefit of earlier filing date presented in the application as filed. On August 14, 2002, applicants submitted a preliminary amendment canceling this claim. Consequently, this objection has been traversed.

Additionally, claims 1-20 were rejected under 35 U.S.C. 103 as allegedly unpatentable over Weiss (U.S. Patent No. 6,077,162). Applicants believe that the rejection over Weiss should be withdrawn.

At the outset, applicants note that they have amended claims 1 and 11 to clarify, and perhaps enlarge, the scope of the claims, rather than to narrow the scope of the claims. For instance, claims 1 and 11 originally recited that the first and second game components were "mutually exclusive." By this phrase, applicant's intended to convey that the outcome of the first game component was determined independently from the second game component, and vice versa, as is now reflected in the amended claims. The above-rejection recognized that this was the meaning to be associated with this language, as the rejection expressly addressed the independence of the determination of the outcomes (although applicants disagree, below, with the suggestion that Weiss discloses, teaches or suggests this subject matter). See Office Action, page 3, lines 12-16. In regard to the language of the preamble that has been removed, applicants note that much of the language is redundant with that recited elsewhere in the body of the claim, and believe that which is not redundant is not necessary for the patentability of the claims.

Claim 1 recites a dual wagering game method. The method includes making a first wager on the outcome of a first game component. The method also includes recognizing an initial value zero for an outcome accumulator value of a second game component, making a first wager on the outcome of said second game component, determining the outcome of said second game component, the determination of the outcome of the second game component being independent of the outcome of the first game component, determining the value of the outcome of said second game component, and adding the value of the outcome of said second game component to said outcome accumulator value of said second game component. The method further includes determining the outcome of said first game component, the determination of the outcome of the first game component being independent of the outcome

of the second game component, and determining the value of the outcome of said first game component. Moreover, the method includes recognizing a game terminating event and realizing a payoff equal to the product of said value to the outcome of said first game component and said outcome accumulator value of said second game component upon occurrence of said game terminating event.

Weiss does not disclose, suggest or teach each and every element of the claimed subject matter of claim 1. Weiss states that the cooperative group gaming system 10 includes gaming machines  $G_1$  through  $G_N$  that have individual and communal play means 40, 50. Col. 3:22-30. Individual play and communal play may result in payout of individual jackpots and communal jackpots. Col. 4:9-15. Moreover, the payout of the individual jackpots occurs according to a pay table for each gaming machine. Fig. 2; Col. 4:6-9 and 34-37. As to the communal jackpot, Weiss states that "the process group gaming operation includes the steps of determining if the player  $P_i$  has a winning outcome according to a pay table and/or any active bonus combinations." Col. 4:42-45. If the player has obtained an outcome that matches a bonus combination, then the communal jackpot is distributed among the winner, player  $P_i$ , and the other players participating in the communal jackpot. Fig. 4 (steps 1-3); Col. 4:45-56.

Therefore, in Weiss, the outcome of the communal game is dependent upon the outcome of the individual game. There is no determination the outcome of said second game component, the determination of the outcome of the second game component being independent of the outcome of the first game component, or determination the outcome of said first game component, the determination of the outcome of the first game component being independent of the outcome of the second game component. Further, in Weiss, the payout of the communal game is added to the outcome of the individual game once the determination is made whether the combination is a matching combination. There is no realization of a payoff equal to the product of said value to the outcome of said first game component and said outcome accumulator value of said second game component upon occurrence of said game terminating event. Consequently, the rejection based on Weiss should be withdrawn.

As to a suggestion that it would be obvious of one of ordinary skill in the art to make the individual play and communal play of Weiss independent, applicants note that such a

modification of Weiss would be contrary to the express statements of Weiss that the games are dependent one on the other. In addition to those passages cited above, note also, for example, col. 3:35-38: “[W]hen at least one player ‘hits’ a recognized winning outcome, a series of awards is distributed to communal players via communal payout means 60.” Thus, for this reason as well, the suggested modification would run contrary to Weiss, and is not appropriate.

Given that claims 2-9 depend from claim 1 and that claim 1 is distinguishable from Weiss, so too are claims 2-9. Moreover, it is applicant’s position that the arguments distinguishing claim 1 from Weiss are applicable with equal force to claim 11, and thus claim 11 also is patentable over Weiss. It further follows that as claim 11 distinguishes Weiss and claims 12-19 depend from claim 11, these claims are patentable over Weiss as well. Therefore, the rejection of claims 1-9 and 11-19 as allegedly unpatentable over Weiss should be withdrawn.

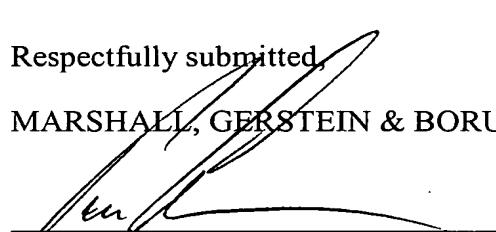
Lastly, claims 21-23 were rejected as allegedly unpatentable under the judicially-created doctrine of obviousness-type double patenting over Tracy et al. (U.S. Patent No. 6,416,408). Applicants have cancelled claims 21-23, without prejudice to refile the claims at a later date. Consequently, the obviousness-type double patenting rejection should be withdrawn.

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Date: August 13, 2003

By:

Respectfully submitted,  
MARSHALL, GERSTEIN & BORUN

  
Paul C. Craane  
Registration No. 38,851  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606-6357  
(312) 474-6300